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PTO/SB/64a (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
FOR FAILURE TO NOTIFY THE OFFICE OF A FOREIGN OR INTERNATIONAL
FILING (37 CFR 1.137(f))**

Docket Number (Optional)
55531 (45676)

First named inventor: James P. Mack

Application No.: 09/833,755

Art Unit: 1764

Filed: April 11, 2001

Examiner: E. M. McAvoy

Title: TRIBOLOGICAL MATERIALS AND STRUCTURES AND METHODS FOR MAKING THE
SAME

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX: (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (703) 305-9282.

The above-identified application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely
notify the Office of the filing of an application in a foreign country or under a multinational international treaty that
requires publication of applications eighteen months after filing. The date of abandonment is the day after the
expiration date of the forty-five (45) day period set in 35 U.S.C. 122(b)(2)(B)(iii).

PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION
UNDER 37 CFR 1.137(b)

1. Petition fee

☒ Small entity – fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status.
See 37 CFR 1.27.

☐ Other than small entity – fee \$ _____ (37 CFR 1.17(m))

2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))

Subsequent to the filing of the above-identified application, an application was filed in another country, or under a
multinational international treaty (e.g., filed under the Patent Cooperation Treaty), that requires publication of
applications eighteen months after filing. The filing date of the subsequently-filed foreign or international application is

February 7, 2002

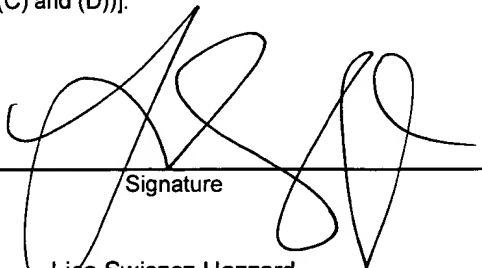
Page 1 of 3

01/04/2005 HALI11 00000039 041105 09833755

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STATEMENT: The entire delay in filing the required notice of a foreign or international filing from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].



Signature

December 29, 2004

Date

Lisa Swiszczy Hazzard

Typed or printed name

44,368

Registration Number, if applicable

EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, Massachusetts 02205

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Telephone Number

Enclosures: ☒ Fee Payment☒ Additional sheets containing statements establishing unintentional delay☒ Other: Return Receipt Postcard



Docket No.: 55531 (45676)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Edward J. Mack

U.S.S.N.: 09/833,755

GROUP ART UNIT: 1756

FILED: April 11, 2001

EXAMINER: Ellen M McAvoy

FOR: TRIBOLOGICAL MATERIALS AND STRUCTURES AND METHODS FOR
MAKING THE SAME

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ADDITIONAL SHEETS CONTAINING STATEMENTS ESTABLISHING
UNINTENTIONAL DELAY**

Dear Sir:

The following statement is submitted in support of the attached *Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))*.

1. On April 11, 2001, the subject application was filed by Applicants' previous patent counsel, Salter & Michaelson. The application claims priority to two provisional applications filed on July 28, 2000. Applicants' previous counsel filed, with the application documents, a Request for Non-Publication pursuant to 35 U.S.C 122(b)(2)(B)(i).
2. Subsequent to April 11, 2001, the prosecution of the subject application ("subject application"), as well as a second application ("second application"), was transferred from Salter & Michaelson to Edwards & Angell. I was asked to handle prosecution of both applications.
3. In June of 2001, a Change of Address form was filed with the United States Patent and Trademark Office (USPTO), thereby changing the correspondence address from Salter & Michaelson to Edwards & Angell. Despite the filing of this Change of Address form, the USPTO continued to direct correspondence Salter & Michaelson until at least October, 2002.

4. On July 18, 2001, Salter & Michaelson delivered, to Edwards & Angell, files holding copies of documents relating to the subject application as well as the second application. Upon receipt and review of the files, I did not note that a Request for Non-Publication pursuant to 35 U.S.C 122(b)(2)(B)(i) had been filed in the subject application by Salter & Michaelson.
5. On July 27, 2001, I filed a counterpart Patent Cooperation Treaty (PCT) application as requested by applicants. At this time, I did not note that a Request for Non-Publication pursuant to 35 U.S.C 122(b)(2)(B)(i) had been filed in the subject U.S. Non-Provisional application by Salter & Michaelson. Thus, I did not file a Request for Rescission of Previous Non-Publication Request in the subject U.S. application (pursuant to 35 U.S.C 122(b)(2)(B)(ii)) as required.
6. On February 7, 2002, the PCT application was published as WO 02/10320. The PCT publication included reference to the subject pending U.S. application and the two priority U.S. provisional patent applications. The PCT application was subsequently allowed to lapse without additional national phase filings.
7. On September 29, 2004, the USPTO mailed an Office Action to Edwards & Angell. In December of 2004, while preparing a response to the Office Action, Mark D. Russett (who was handling prosecution of the subject application while I was on leave) noted that the official Filing Receipt from the USPTO indicated that a Non-Publication Request had been filed. It was further noted that a PCT application had been filed without the filing of a Request for Rescission of Previous Non-Publication Request in the subject U.S. application and, further, that the USPTO had not been notified of the foreign or international filing (as required by 35 U.S.C 122(b)(2)(B)(iii)).
9. A review of the files showed that the early prosecution documents of the subject application were misfiled. In particular, these documents were placed in the file of the second application rather than the file of the subject application. Among the misfiled documents were the application transmittal documents including the Request for Non-Publication.
10. Thus, Applicants respectfully submit that the application became abandoned due to a failure to note the filing of a Request for Non-Publication in the subject U.S. application. Because I was not aware that a Request for Non-Publication had been filed by Salter & Michaelson, I filed a PCT application without filing a Request for Rescission the Non-Publication Request. This was due to a combination of unusual factors wherein an initial U.S.



Non-Provisional application was filed with a Request for Non-Publication by Applicants' previous counsel and, three months later, I was asked to file a corresponding PCT application. Upon receipt and review of the transferred files, the Request for Non-Publication, which was misfiled, was not noticed.

11. Upon discovery of the listing of this Request for Non-Publication in the filing receipt, an investigation of the various files was conducted revealing the facts described above.

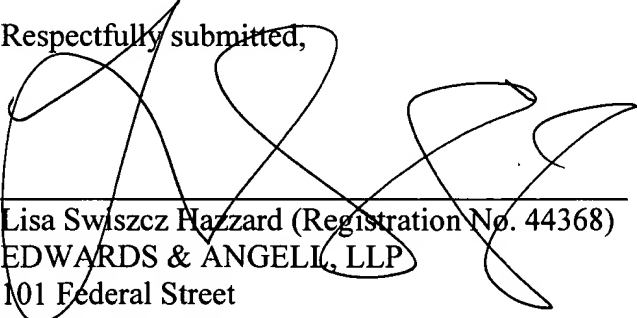
The undersigned therefore promptly files the accompanying Petition. The undersigned again states that the entire delay in submitting the required notice of a foreign or international filing, from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b), was unintentional.

CONCLUSION

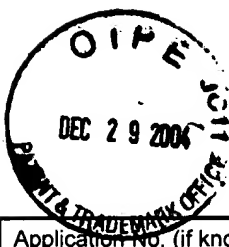
In accordance with 37 C.F.R. §1.17(m), Applicants authorize the Commissioner to charge our Deposit Account No. **04-1105** in the amount of \$750.00 to cover the petition fee (for a small entity). Applicants believe that additional fees are not required in connection with this submission. However, if a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge/credit Deposit Account No. **04-1105**.

If a telephone conversation with Applicants' attorney would expedite consideration and granting of this position, the Commissioner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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Application No. (if known): 09/833,755

Attorney Docket No.: 55531 (45676)

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV 437816861 US in an envelope addressed to:

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 29, 2004
Date

Kathryn A. Grindrod
Signature

Kathryn A. Grindrod

Typed or printed name of person signing Certificate

Registration Number, if applicable

(617) 517-5534
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Petition to Revive Application Abandoned for Failure to Notify (2 pages)
Additional Sheets Containing Statements Establishing Unintentional Delay
(3 pages)
Authorization to charge \$1,500.00 to deposit account 04-1105
This Return Receipt Postcard